

REMARKS

This application has been carefully reviewed in light of the Office Action dated March 18, 2004. Claims 12-23 remain pending in this application. Claims 12, 16, and 20 are the independent claims. Favorable reconsideration is respectfully requested.

On the merits, the Office Action rejected Claims 12-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,298,222 in view of Shimo et al. (U.S. Patent No. 5,774,797; hereinafter "Shimo"). Applicants respectfully traverse the rejection because 6,298,222 and Shimo cannot be properly combined because Shimo recites a DC/DC converter that is used as a step up means to step up the output voltage of the battery 20 from 3 to 5.5 V when power is shifted from RF power amplifier 2 to RF power amplifier 12. (See, e.g., Col. 7, lines 1-27) Shimo calls for separate amplifiers whereas 6,298,222 calls for fine tuning the required RF output power of an RF power amplifier. Shimo provides neither fine tuning, nor adjusting the RF output power of a single amplifier. Applicants respectfully request the withdrawal of the obviousness-type double patenting rejection.

Further on the merits, the Office Action rejected Claims 12-23 under 35 U.S.C. § 103(a) as being unpatentable over Toda (U.S. Patent No. 5,603,106; hereinafter "Toda") in view of Shimo.

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5

Applicants respectfully submit the pending Claims are allowable for at least the following reasons:

Neither Toda, Shimo, or the combination of Toda and Shimo recite or suggest a power of said communication device is varied in dependence of said frequency value by controlling a DC/DC converter, the control input value of which is exclusively controlled in dependence of said frequency value, to vary an electrical supply of the amplifier. Rather, as stated in the Office Action, Toda fails to recite or suggest a DC/DC converter. Shimo's DC/DC converter is used as a step up means to step up the output voltage of the battery 20 from 3 to 5.5 V when power is shifted from RF power amplifier 2 to RF power amplifier 12. (See, e.g., Col. 7, lines 1-27) Shimo's DC/DC converter is not used in dependence on a frequency value of an amplifier to vary an electrical supply of that amplifier. Rather, Shimo's DC/DC converter is used to shift power requirements between two separate amplifiers. This does not take into account for power dissipation across an RF power amplifier in a mobile communication environment. Thus the combination of Toda and Shimo fails to recite or suggest every element of Applicants' Claim 12. Thus the rejection of Applicants' Claim 12 is respectfully traversed.

In addition, the Office Action justifies the motivation to combine Toda and Shimo by stating "it would have been obvious to adjust the voltage supply at different power levels to the portable

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telephone by increasing the voltage supply to the power amplifier when the telephone is in a transmission mode and decreasing the voltage supply when the telephone is in a receiving mode in order to conserve the power of the battery." M.P.E.P. § 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully believe that Shimo fails to provide suggestion to modify Toda's device structure to include a DC/DC converter to vary an electrical supply of one amplifier. Shimo uses a DC/DC converter to vary the voltage between two amplifiers. One of ordinary skill in the art would not have the requisite motivation to combine the references because Shimo does not vary a power of the communication device in dependence of the frequency value from one amplifier. Applicants respectfully submit that the § 103 rejection of Claim 12 additionally fails because no expectation of success exists, as Shimo requires two amplifiers 2

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7

and 12 with altering power requirements. Claim 12 is believed patentable for at least these reasons.

Claims 16 and 20 recite a communication device and a method substantially corresponding to the communication system of Claim 12 and are believed patentable for at least the same reasons.

Claims 13-15, 17-19, and 21-23 depend from one or another of the independent Claims recited above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 13-15, 17-19, and 21-23 to be independently patentable and request separate consideration of each claim.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached by telephone at the number given below.

Respectfully submitted,

By 

Aaron Waxler,

Reg. 48,027

(914) 333-9608

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